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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,569	11/09/2000	Makiko Endo	35.C14920	2291
5514	7590	07/11/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SCHWARTZ, PAMELA R	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/708,569

Applicant(s)

ENDO ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23,24,29-32 and 53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23,24, 29-32 and 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Finality of the last office action is withdrawn.
2. Claims 23, 24, 29-32 and 53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 6,830,709. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent, directed to an ink set, liquid composition, method, and apparatus, recite the inclusion of coloring material and fine particles that react with the coloring material to adsorb the coloring material onto the surface of the particles. This method seems to be the same as that used to make the instantly claimed invention so that any limitations of the instant claims that are not specifically set forth by the patent claims are considered to be inherent from the method disclosed therein. Since the ink set would be used to make the instantly claimed invention, and the particulars of how to make the claimed imaged article are recited by the patent claims, the instantly claimed invention is obvious therefrom.
3. Claims 23, 24, 29-32 and 53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of U.S. Patent No. 6,536,890. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims recite a liquid composition, an ink set, an image forming method, apparatus and a method of alleviating bleeding. See for example claims 34 and 35, which recites a method of applying the claimed liquid composition so that coloring material from the ink is adsorbed or bound to the surface of oppositely charged micro-particles. This method seems to be the same as that used to make the instantly claimed invention so that any

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limitations of the instant claims that are not specifically set forth by the patent claims are considered to be inherent from the method disclosed therein. Since the ink set would be used to make the instantly claimed invention, and the particulars of how to make the claimed imaged article are recited by the patent claims, the instantly claimed invention is obvious therefrom.

4. Claims 23, 24, 29-32 and 53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. 6,863,391. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent discloses a liquid composition, an ink set, a method of forming a colored section on a medium, and an apparatus. Since the claimed method steps seem to be the same or similar to those of the instant application, the limitations of the instant claims that are not specifically disclosed by the patent claims are considered to be inherent therefrom.

5. Applicant's arguments with respect to claims 23, 24, 29-32 and 53 have been considered but are moot in view of the new ground(s) of rejection.

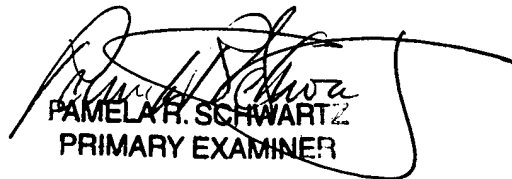
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
July 3, 2006



PAMELA R. SCHWARTZ
PRIMARY EXAMINER